

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

Appellant:	HARRY V. WEBER)	Examiner:	H. Dass
)		
Serial Number:	10/054,689)	Group Art Unit:	3695
)		
Filed:	November 13, 2001)	Customer Number:	22827
)		
Confirmation No.:	5262)	Deposit Account:	04-1403
)		
Title:	VIRTUAL FINANCIAL AID OFFICE)	Attorney Docket No.	WBE-1

1. **NOTICE OF APPEAL:** Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals and interferences from the last decision of the Examiner.
2. **PRE-APPEAL BRIEF REQUEST FOR REVIEW:** Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated on the attached sheet(s) [No more than five (5) pages may be provided.]
3. **BRIEF** on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy).
4. An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within two months after Examiner's Answer).
5. Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).
6. "Small entity" verified statement filed: [] herewith [X] previously.

7. **FEE CALCULATION:**

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PETITION is hereby made to extend the original due date of October 10, 2010, hereby made for an extension to cover the date this response is filed for which the requisite fee is enclosed (1 month \$130; 2 months \$490; 3 months \$1,110; 4 months \$1,730, 5 months \$2,350) \$ 0.00

SUBTOTAL: \$ 540.00

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Less any previous fee paid for prior Notice of Appeal since Board did not render a decision on the merits. MPEP § 1204.01 - \$ 0.00

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The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any fees in addition to the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (deficiency only) now or hereafter relative to this application and the resulting official document under Rule 20, or credit any overpayment, to our Account No. shown in the heading hereof. This statement does not authorize charge of the issue fee in this case.

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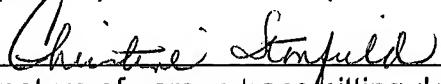
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I hereby certify that this correspondence and all attachments and any fee(s) are being electronically transmitted via the internet to the U.S. Patent and Trademark Office using the Electronic Patent Filing System on October 12, 2010.

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PATENT
ATTORNEY DOCKET NO: WBE-1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

Appellant: Harry V. Weber)	Examiner: Harish T. Dass
)	
Serial No: 10/054,689)	Art Unit: 3692
)	
Filed: November 13, 2001)	Deposit Acct. No: 04-1403
)	
Title: Virtual Financial Aid Office)	Confirmation No: 5262
)	
)	Customer No: 22827

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BRIEF ON APPEAL

Honorable Commissioner:

Appellant submits the following Brief on Appeal in accordance with 37 C.F.R. § 41.37:

1. REAL PARTY IN INTEREST

The real party in interest in this matter is the Assignee of record, Weber & Associates, Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellant or the Appellant's legal representative which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS

Claims 11-13, 15, 17, 19-25, 56-57 and 59-66 are currently pending in the captioned application, including independent claims 11 and 60. Claims 1-10, 14, 16, 18, 26-55 and 58 have been previously canceled. All of the pending claims involved in this Appeal are attached hereto in the Claims Appendix.

Claims 11-13, 15, 17, 19-25, 56-57 and 59-66 stand rejected. The rejections of claims 11-13, 15, 17, 19-25, 56-57 and 59-66 are hereby appealed.

4. STATUS OF AMENDMENTS

Claims 11-13, 15, 17, 19-25, 56-57 and 59-66 are currently presented in the Claims Appendix in a form as set forth in the Requested Amendments submitted on July 12, 2010 after the Final Rejection of such claims. Examiner Dass indicated in his July 23, 2010 Advisory Action that such amendments will be entered for purposes of appeal. Appellant appreciates the entry of such amendments for appeal purposes.

Appellant also appreciates that the previously submitted amendments have been indicated as sufficient to overcome the prior rejections under both 35 U.S.C. § 112 and § 101. Such amendments were presented to clarify that the pending claims are directed to a computer-implemented, web-based application in conjunction with its corresponding physical structure, i.e., the computer-readable medium comprising instructions for executing the web-based application. The tangible nature of such claims is now evident from the amended claim preambles, as well as in other original claim limitations, for example, the limitations in independent claims 11 and 60 that describe a variety of modular

services as “web-based” and implemented in an “automated on-line” environment, thus requiring the use of computer-implemented technology that is connected to, served by, or available through a computer or telecommunications system (such as the Internet). The implementation of the service-based software modules of independent claims 11 and 60 through a computer-readable medium is consistent with the description in the subject application that such services are embodied in a unique system of software and processing (see paragraph [0045] of the published application), which involve sophisticated algorithms, rules engines and software available in a processing center (e.g., SFAPC 12) – see paragraph [0046] of the published application.

Given the status of the July 12, 2010 Amendments as: (i) entered for purposes of appeal; and (ii) sufficient to overcome the rejections under 35 U.S.C. U.S.C. § 112 and § 101, Appellant appeals the sole remaining rejection under 35 U.S.C. § 103(a).

5. SUMMARY OF CLAIMED SUBJECT MATTER

I. Independent claim 11 is directed to a computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system featuring integrated and automated on-line financial aid features specific to a given educational institution to a user. (See, e.g., p. 1, lines 4-10; p. 4, lines 6-11; p. 6, lines 20-25; p. 10, lines 22-29.) A web-based application for the subject virtual financial aid office (VFAO) features is described as being hosted in on-line platform such as the publicly accessible Internet. (See, e.g., p. 13, lines 9-12; Fig. 1, elements 10, 12; Fig. 4, element

50.) The web-based application includes a first information collection service for obtaining requested personal and financial information about a given student. (See, e.g., pg. 6, lines 24-29; p. 18, lines 10-25.) The web-based application includes a financial aid estimation service (Fig. 2, element 22) for evaluating the information obtained via said first information collection service and generating a predicted amount of monetary aid that may be available for the student to use for education-related expenses at a given educational institution. (See, e.g., pg. 6, lines 26-32; page 18, lines 12-20; Fig. 2, element 22.) The web-based application further includes a federal link service for receiving an electronic copy of an Institutional Student Information Report (ISIR) document for the given student. (See, e.g., page 21, line 17 – page 22, line 2.) The web-based application includes a service for comparing information obtained via said first information collection service and the given student's ISIR document. (See, e.g., Fig. 5 and p. 28, lines 7-28.) The web-based application also includes a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution. (See, e.g., page 27, lines 28-32; Fig. 7; page 30, lines 8-19.) Finally, a service for providing an award notice to the given student based on the determination of authorized financial aid eligibility is provided. (See, e.g., page 24, line 30 – page 25, line 2; page 30, line 31 – page 31, line 4.)

II. Independent claim 60 is directed to a computer-readable medium comprising instructions for executing a web-based application, for providing a multi-level financial aid system featuring integrated and automated on-line

financial aid features specific to a given educational institution. (See, e.g., p. 1, lines 4-10; p. 4, lines 6-11; p. 6, lines 20-25; p. 10, lines 22-29; p. 13, lines 9-12.). The web-based application includes an information collection service for obtaining requested personal and financial information about one or more students. (See, e.g., pg. 6, lines 24-29; p. 18, lines 10-25.) The web-based application further includes a financial aid estimation service for evaluating the information obtained via said first information collection service and generating a predicted amount of monetary aid that may be available for each student to use for education-related expenses at a given educational institution. (See, e.g., pg. 6, lines 26-32; page 18, lines 12-20.) The web-based application further includes a service for determining an authorized amount of financial aid each student is eligible for at the given educational institution. (See, e.g., pg. 6, lines 26-32; page 18, lines 12-20.) The web-based application also includes a service for providing an award notice to each student based on the determination of authorized financial aid eligibility. (See, e.g., page 24, line 30 – page 25, line 2; page 30, line 31 – page 31, line 4.) Finally, the web-based application also includes a reporting service, available to the given educational institution, for generating reports of selected students and their respective financial aid packages. (See, e.g., page 5, lines 11-14 and page 23, line 7 – page 24, line 12.)

III. Dependent claim 61 is directed to a computer-readable medium comprising instructions for executing a web-based application of claim 60. Claim 61 requires two additional limitations relative to independent claim 60. In particular, claim 61 requires a federal link service for receiving an electronic copy

of an Institutional Student Information Report (ISIR) document for the given student. (See, e.g., page 21, line 17 – page 22, line 2.) Claim 61 also requires a service for comparing information obtained via said first information collection service and the given student's ISIR document. (See, e.g., Fig. 5 and p. 28, lines 7-28.)

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I. Whether claims 11-13, 15, 17, 19-25 56-57, 59-66 are patentable under 35 U.S.C. §103(a) over "Financial Aid Prospecting – ONLINE: The Internet is Loaded with Valuable Financial Aid Information, but Few Campus Web Sites Are Designed to Help Them Find It," Terrell, Kenneth, Black Issues in Higher Education, Reston: Oct. 28, 1999, Vol. 16, Iss. 18, pg. 38 (hereinafter "Terrell") in view of U.S. Patent No. 7,062,462 (Ireland et al.) and further in view of U.S. Patent No. 5,870,721 (Norris) and further in view of Applicant's Admitted Prior Art (AAPA).

7. ARGUMENT

I. **Claims 11-13, 15, 17, 19-25, 56-57 and 59-66 are patentable under 35 U.S.C. § 103(a) over "Financial Aid Prospecting – ONLINE: The Internet is Loaded with Valuable Financial Aid Information, but Few Campus Web Sites Are Designed to Help Them Find It," Terrell, Kenneth, Black Issues in Higher Education, Reston: Oct. 28, 1999, Vol. 16, Iss. 18, pg. 38 (hereinafter "Terrell") in view of U.S. Patent No. 7,062,462 (Ireland et al.) and further in view of U.S. Patent No. 5,870,721 (Norris) and further in view of Applicant's Admitted Prior Art (AAPA).**

The pending rejection citing Terrell, Ireland et al., Norris and AAPA fails to constitute a prima facie case of obviousness under 35 U.S.C. § 103(a). The combination of references fails to disclose the one or more elements set forth in

independent claims 11 and 60. A person of ordinary skill in the art, having common sense at the time of the invention, would not have reasonably looked to the combination of references set forth in Final Office Action. Finally, secondary considerations including evidence of commercial success bolster a finding of nonobviousness of the pending claims over the cited references. As such, Appellant respectfully submits that claims 11-13, 15, 17, 19-25, 56-57 and 59-66 are patentable under 35 U.S.C. § 103 over the cited combination of references.

A. The combination of Terrell, Ireland et al., Norris, and AAPA fails to teach or suggest all limitations of independent claims 11 and 60.

Nowhere has the USPTO's burden of establishing a prima facie case of unpatentability been more articulated than within the context of obviousness analysis under 35 U.S.C. § 103. The legal concept of prima facie obviousness is a procedural tool of examination that dictates who has the burden of producing evidence in each step of the examination process. The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. See, e.g., *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. 398, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Not only must a prima facie case of obviousness be clearly articulated by the Examiner, but the cited references must actually disclose all limitations of a rejected claim. To establish a prima facie case of obviousness, in addition to other requirements, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In light of the above requirements, Appellant submits that the Examiner has failed to establish a required prima facie case of obviousness. The cited references, singularly or in combination, fail to disclose many of the elements of independent claim 11. Key among such elements are the following web-based online and automated modular features which are important to the web-based application for providing a multi-level financial aid system featuring integrated and automated on-line financial aid features to a user, as set forth in claim 11. In

particular, such references fail to disclose the following features: an automated online “federal link service for receiving an electronic copy of an Institutional Student Information Report (ISIR) document for a given student,” an automated online “service for comparing information obtained via said first information collection service and the given student’s ISIR document,” and an automated online “service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution.” The above elements are also described in the combination of claims 60 and 61, which are also presently rejected.

1. Terrell fails to disclose all limitations of independent claims 11 and 60.

Regarding claim 11, the Examiner has aptly acknowledged the many deficiencies of Terrell as a base reference. More particularly, as indicated on numbered pages 7 and 8 of the May 10, 2010 Office Action, “Terrell does not explicitly disclose [the following elements of claim 11:]

a financial aid estimation service for evaluating the information obtained via said first information collection service and generating a predicted amount of monetary aid that may be available for the student to use for education-related expenses at a given educational institution;

receiving an electronic copy of an Institutional Student Information Report (ISIR) document for the given student;

a service for comparing information obtained via said first information collection service and the given student’s ISIR document;

a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution; and

a service for providing an award notice to the given student based on the determination of authorized financial aid eligibility.”

There are further deficiencies of Terrell as a base reference beyond those explicitly identified in the final Office Action (listed above). Terrell does not even disclose the few limited aspects alleged on numbered page 7 of the May 10, 2010 Office Action. Such portion of the Office Action alleges that “Terrell discloses ... a first information collection service for obtaining requested personal and financial aid information about a given student [see NPL 7 pages], Internet FTP for transferring files, a federal link service (see web page link to www.fafsa.ed.gov) [sic].” Nowhere in the 7 pages printed out from an apparent Internet archive is there a discussion of any of these claimed features. Terrell does not specifically disclose any of the claimed features of claim 11 – nothing about the specifically recited information collection service, nothing about FTP file transfer, and nothing about a “federal link service for receiving an electronic copy of an Institutional Student Information Report (ISIR) document for the given student.” The only thing accurate about the above statement regarding Terrell is that the Department of Education provides a link at www.fafsa.gov for students to complete their Federal Application for Financial Aid (FAFSA) online.

Terrell is a brief 1400 word article that makes vague mention of the fact that the Internet has valuable financial aid information online, and lists a plurality of websites where students can go to find information. Everyone knows that you

can read information accessible on the Internet, just like one could read a book about a subject when that book is made available on the Internet. Providing links to information is NOT the same as providing a functional web-based software application that has specific functionality and practical application, such as set forth in claims 11-13, 15, 17, 19-25, 56-57 and 59-66. There is NOTHING in Terrell that talks about providing a web-based application for providing a multi-level financial aid system featuring integrated and automated on-line financial aid features specific to a given educational institution to a user. In fact, Terrell is so devoid of disclosing any of the functional features set forth in the claims, Appellant is unclear of why it is even being applied as a base reference.

Because Terrell fails to disclose numerous features of claim 11, such reference cannot serve to render such claim unpatentable. Similar features from claim 11 are set forth in claims 60, 61 and others. As such, Terrell cannot serve to render such additional claims unpatentable. As detailed below, the other cited references fail to cure the many deficiencies of Terrell.

2. Ireland et al. fails to cure the deficiencies of Terrell with respect to independent claims 11 and 60.

Claim 11 is generally directed to a comprehensive online system that includes features for the actual processing of financial aid applications. Ireland et al. merely provides an interface for viewing and analyzing previously processed award packages to a student. For instance, in col. 6, lines 20-34, Ireland et al. disclose how it is still the responsibility of a school administrator to generate a financial aid package and preferably mail a letter to a potential student containing an announcement of the financial aid package. The viewing of the package by a

student or parent may then occur upon accessing a given URL address and supplying a user name and password.

Ireland et al. provides a plethora of features that may be utilized to view award packages, predict loan repayment amounts, etc. but such reference still does not disclose features for the actual processing of such awards as set forth in claims 11, 60, 61 and others of the subject application. More specifically, processing features set forth in claims 11, 60 and 61 not sufficiently described in Ireland et al. include respective services for obtaining personal and financial information about a given student, receiving an electronic copy of an Institutional Student Information Report (ISIR) document for a given student, comparing the student's personal and financial information with the ISIR information, and determining an authorized amount of financial aid the student is eligible for (as opposed to a separate previously estimated amount). Because Ireland et al. does not concern processing, it never addresses any of these same important features of claims 11, 60 and 61 that are also lacking in Terrell.

3. AAPA fails to cure the deficiencies of Terrell with respect to independent claims 11 and 60.

The recent Office Action further attempts to cure the deficiencies of Terrell (and Ireland et al.) with background information set forth in the subject application. More particularly, the Examiner alleges on numbered page 9 of the May 10, 2010 Office Action that “[Applicant’s Admitted Prior Art (AAPA)] discloses evaluating the information received via said first information collection service; a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution.] This is an improper

characterization of what is disclosed in the Background of the Invention section of the subject application, and Appellant respectfully submits that such disclosure clearly does NOT correspond to the elements set forth in claim 11.

The Background of the Invention section of the subject application generally describes the cumbersome manual interaction that often existed in a school's financial aid office before provision of the subject Virtual Financial Aid Office (VFAO) technology. Instead of prior arrangements described there, the entire system and process by which a student goes about obtaining financial aid is transformed by the subject VFAO technology. By providing an integrated on-line web-based application, a student is now capable of undergoing an online student interview process by which personal, demographic and financial information can be provided in a secure portal, using high bit-level encryption, protection from third-party intrusion and the like. Additional automated online tools and resources are also available, where they weren't before. For example, a student is provided with instant access to the platform (after completing an automated online PIN application) to provide additional updated information, and also to obtain a financial aid estimate (via the financial aid estimation service tool) before actual authorized aid packages are processed. Specific algorithms and rules engines are implemented via software to perform various processing steps including interview processing, file review, aid determination and quality control (see steps and discussion relative to Figures 4-7, respectively).

None of the above automated, computer-based features are discussed as admitted prior art in the subject application. In contrast, the various

embodiments of the invention, not the prior art, are described in the subject application as including the features set forth in claim 11. In particular, three of the important steps in automated aid processing as set forth in claim 11 include: a service for receiving an electronic copy of an Institutional Student Information Report (ISIR) document for a given student; a service for comparing information obtained via said first information collection service and the given student's ISIR document; and a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution. None of these are disclosed in the Background section, nor could any of these be part of a "web-based application" that provides "integrated and automated on-line financial aid features" to a user since the only financial aid interaction discussed in the Background involved a different sort of manual interaction among entities involved in the traditional financial aid process. As such, AAPA fails to cure the many deficiencies of Terrell and Ireland et al.

4. Norris fails to cure the deficiencies of Terrell with respect to independent claims 11 and 60.

The May 10, 2010 Office Action further attempts to cure the deficiencies above with the disclosure in U.S. Patent No. 5,870,721 (Norris), in which loan approval technology is argued as analogous to the specific steps of claim 11. Norris fails to disclose all elements of claims 11, 60 and 61. Numbered page 9 of the May 10, 2010 Office Action asserts that Norris discloses "receiving an electronic copy of loan document or borrower (analogous to an Institutional Student Information Report (ISIR) document for the given student); a service for comparing information obtained via said first information collection service

(database – analogous service) and the given borrowers loan application/document (analogous to student's ISIR document)." It seems apparent not only from the Norris patent itself, but even from the Examiner's characterization of such reference, that Norris doesn't have anything to do with receipt of student aid information and subsequent processing thereof.

In particular, claims 11 and 61 recite an automated on-line "federal link service for receiving an electronic copy of an Institutional Student Information Report (ISIR) document for a given student." Norris doesn't once mention anything about applying its loan processing techniques to students, nor does it mention anything about ISIR documents, both of which are of particular importance to the automated processing in claims 11 and 61. Since Norris fails to disclose an automated service for receiving a student ISIR document, a feature that was not disclosed in Terrell, nor Ireland et al., nor in AAPA, this feature of claims 11 and 61 is still not disclosed in the cited art. A prima facie case of obviousness under 35 U.S.C. § 103(a) has not been met because none of the cited art discloses a federal link service for receiving an electronic copy of an ISIR for a given student.

In addition, claims 11 and 61 recite "a service for comparing information obtained via said first information collection service and the given student's ISIR document." None of the cited references discloses receiving a student ISIR document, so none of the cited references are capable of disclosing information contained in such an electronic document. Norris doesn't relate to student aid, nor does it disclose information on an ISIR document, so Norris again fails to

cure this particular deficiency of Terrell, Ireland et al. and AAPA relative to claims 11 and 61. A *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been met because none of the cited references discloses an automated service for comparing information obtained via said first information collection service and the given student's ISIR document.

Still further, claims 11 and 60 recite a "service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution." As discussed above, neither Terrell nor Ireland et al. discloses this feature. Norris fails to cure this deficiency for many clear reasons. Norris does not analyze student aid, and gives no apparent consideration to the requirements for "authorization" that uniquely apply to student aid as opposed to general loans for other reasons. As indicated in claims 11 and 60, eligibility is tied to a given educational institution. Since Norris doesn't involve students or student financial aid, Norris does not disclose and has no reason to consider the special factors required to analyze institution-specific eligibility for student funds – including but not limited to cost of tuition, books, living expenses, full-time vs. part-time student status, verification of student enrollment, availability of scholarships, grants and other NON-LOAN financial aid, etc. Norris does not disclose determining an authorized amount of student financial aid for a student because none of the student-specific analytical requirements are analyzed in Norris. Norris does not disclose determination of eligible student aid for a given educational institution because Norris doesn't consider specific schools or information related to a school sufficient to determine what a student may or may

not be "eligible" for at a specific institution. A *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been met because none of the cited art, including Norris, discloses a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution.

The combination of cited references, including Terrell, Ireland et al., Norris and AAPA, fail to disclose, singularly or in combination, all elements of claims 11 and 60. In particular, such references fail to disclose the following features of claim 11: an automated online "federal link service for receiving an electronic copy of an Institutional Student Information Report (ISIR) document for a given student," an automated online "service for comparing information obtained via said first information collection service and the given student's ISIR document," and an automated online "service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution." Such references also fail to particularly disclose the following feature of claim 60: an automated online "service for determining an authorized amount of financial aid each student is eligible for at the given educational institution."

As such, independent claims 11 and 60 are patentable over such references.

5. Because dependent claims 12-13, 15, 17, 19-25, 56, 57, 59 and 61-66 further depend from and limit otherwise allowable independent claims 11 and 60, such claims are also patentable under 35 U.S.C. § 103(a).

With regard to claims 12-13, 15, 17, 19-25, 56, 57 and 59, such claims depend from otherwise allowable claim 11 and further limit such independent claim. Similarly, claims 61-66 depend from otherwise allowable claim 60 and further limit such independent claim. If an independent claim is nonobvious

under 35 U.S.C. § 103(a), then any claim depending therefrom is nonobvious. *In re Fine*, 387 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1998), emphasis added.

Since claims 11 and 60 should be allowed over the cited art, so should claims 12-13, 15, 17, 19-25, 56, 57, 59 and 61-66. Appellant respectfully requests acknowledgement of allowance.

B. A person of ordinary skill in the art, having common sense at the time of the invention, would not have reasonably looked to Ireland et al. or Norris for combination with Terrell as suggested in the Final Office Action.

Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), and includes ascertaining differences between the claimed invention and the prior art, while resolving the level of ordinary skill in the pertinent art.

1. No proper rationale has been provided as to why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. “Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re*

Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). The courts have even provided numerous examples of rationales that may support a conclusion of obviousness.

Appellant respectfully submits that no documentary evidence, either in the cited references themselves or elsewhere in the record, has been put forth to support the rationale for combining references provided in the Office Action. The Examiner has failed to clearly articulate why one of ordinary skill in the art would have looked to the secondary references to cure the deficiencies of the base reference Terrell. For each instance in which a new reference is combined with the base reference Terrell, the final Office Action simply asserts that “it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Terrell” to include other features identified in the claims. (See May 10, 2010 Office Action, numbered page 8, second paragraph, regarding modification of Terrell to include features from Ireland et al.; numbered page 9, first paragraph, regarding modification of Terrell and Ireland et al. to include features from AAPA; numbered page 10, first paragraph, regarding modification of Terrell, Ireland and AAPA to include features from Norris.)

Because the Examiner has failed to explicitly or implicitly provide a proper rationale for the suggested combination of references, a prima facie case of obviousness under 35 U.S.C. § 103(a) has not been established.

- 2. Only improper hindsight gained from exposure to Appellant’s disclosure would lead the person of ordinary skill from Terrell, Ireland et al., Norris, AAPA and “common**

knowledge" to the limitations of claims 11-13, 15, 17, 19-25, 56-57 and 59-66.

The Supreme Court has recently reaffirmed that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. See also, *Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474. "[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (PTO Bd. App. 1985). It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb v. Barnes-Hind/Hydrocurve*, 230 U.S.P.Q. 416, 419-420 (Fed. Cir. 1986)(vacating a district court holding of invalidity for obviousness and criticizing the district court for viewing teachings from the prior art in isolation, instead of considering the prior art references in their entirety; for entering the tempting but forbidden zone of hindsight analysis; for failing to view the claimed invention as a whole; and for disregarding express claim limitations). "[A] rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . It [the Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis...." *In re Warner*, 379 F.2d 1011, ___, 154 U.S.P.Q. 173, 177, 178 (C.C.P.A. 1967).

In the present case, the Examiner has impermissibly used hindsight bias by using the claims as a road map or guide in formulating the Final Rejection of claims 11-13, 15, 17, 19-25, 56-57 and 59-66, which is impermissible under *KSR Int'l Co. v. Teleflex Inc.* and *Graham v. John Deere, Inc.* In particular, in variously rejecting claims 11-13, 15, 17, 19-25, 56-57 and 59-66, the Examiner has failed to articulate any reasoning why one ordinary skill in the art would be led to combine such references, and has blindly combined not just one or two references, but five different sources to achieve the complete combination of features set forth in such claims. While Appellant realizes that such a combination of multiple references is possible, Appellant submits that such a combination is only proper when there is a valid basis for such combination.

In the present case, the Examiner has failed to establish a proper inquiry as to why one of ordinary skill in the art would be led to combine all five sources of information – three references, disclosure within the subject application and alleged “well-known” elements. Plainly, the Examiner’s only basis for modifying the highly deficient base reference Terrell to include the features of not only Ireland et al., but also Norris, AAPA and alleged “well known” elements in a five-way combination of references as asserted in the Final Rejection results from using the Appellant’s own disclosure. The subject application has been used (improperly) via hindsight as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art, which is improper under 35 U.S.C. § 103. The numerosity of the applied sources of alleged prior art information only

increases the likelihood that improper hindsight was used as a justification for combining five references in a § 103 rejection.

Because the record is devoid of a proper basis for how one of ordinary skill in the art would be led to combine the five different sources in rejecting claims 11-13, 15, 17, 19-25, 56-57 and 59-66, such rejection is respectfully improper. Even upon articulation of a basis for combining the multiple cited references, Appellant submits that hindsight analysis is an improper basis for such combination. Appellant respectfully submits that the rejection of claims 11-13, 15, 17, 19-25, 56-57 and 59-66 as obvious over Terrell, Ireland et al., Norris, AAPA and allegedly “well known” elements amounts to impermissible hindsight reconstruction of the claimed subject matter and that all such claims are allowable over the cited references.

C. Commercial Success of the Subject Invention Provides Further Evidence of Non-Obviousness of Claims 11-13, 15, 17, 19-25, 56-57 and 59-66.

The U.S. Supreme Court case of *KSR International Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ 2d 1382 (2007) affirmed that objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. Such objective evidence, referred to as “secondary considerations,” was identified in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) as including evidence of commercial success, long-felt but unsolved needs, failure of others, and unexpected results. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that “evidence rising out of the so-called ‘secondary

considerations' must always when present be considered en route to a determination of obviousness" (emphasis added). (See also MPEP §716.01(a).)

Not only does the cited prior art fail to disclose all elements set forth in the subject claims, but it would not be obvious to combine these references in rendering the presently claimed invention unpatentable. Particular evidence of this non-obviousness was previously submitted in the form of a declaration by sole inventor Harry V. Weber, who is President of Weber & Associates, Inc., the assignee of the subject application. A copy of this declaration is provided in the Evidence Appendix (Section 9) of this Appeal Brief. Such objective evidence identifies commercial success of the subject technology as a pertinent secondary consideration relevant to any current determination of obviousness of the present claims.

The previously submitted declaration is provided under 37 C.F.R. §1.132 as objective evidence of commercial success of a technology offered by Weber & Associates Inc. referred to as their Virtual Financial Aid Office (VFAO) technology. The web-based application for providing a multi-level financial aid system disclosed in the subject application and set forth in the presently pending claims is generally synonymous with the commercial embodiments of Weber & Associates' VFAO technology currently provided and with commercial embodiments provided to its customers since July 1, 2001. Since its complete inception in mid-2001, Weber & Associates has offered its VFAO technology for sale to institutions of higher education, including colleges and universities throughout the country. During the time period from mid-2001 until March 2008,

over thirty-five (35) different colleges and universities purchased and used the VFAO technology provided by Weber & Associates, Inc. and implemented it for use in over eighty (80) different locations in various states throughout the nation. This commercially successful product has generated over \$16.5 million dollars in sales for Weber & Associates from July 1, 2001 until March 2008. The commercial success of the VFAO technology, synonymous with that described by the present claims, is deniably astounding and should thus be given substantial consideration in finding the present claims non-obvious.

The commercial success of the subject technology has not only been realized by the assignee, but also for the educational institutions who have implemented the subject technology. Several of such institutions provide online degree programs and so having an integrated on-line web-based application for providing financial aid services to their students has been critical to their continued ability to function in today's competitive world of higher education. Multiple such institutions have doubled their total number of students during the time period in which VFAO technologies were provided to such institutions, and have thus recognized the value of the VFAO technology to their growth.

Appellant respectfully submits that the subject web-based application for providing integrated on-line financial aid features, as set forth in present claims 11-13, 15, 17, 19-25, 56-57, 59 and 60-66, is not obvious in light of the presently submitted objective evidence of the remarkable commercial success of Appellant's virtual financial aid office technology. Appellant respectfully requests acknowledgement of this non-obviousness.

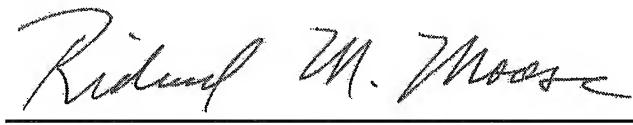
IV. Conclusion

In conclusion, it is respectfully submitted that the present claims are patentable over the prior art of record in accordance with 35 U.S.C. §§ 102 and 103. In particular, the cited references fail to disclose all limitations of the claims, particularly independent claims 11 and 60. In addition, the final Office Action has failed to articulate the level of ordinary skill in the art and the rationale for how such a person would combine the cited references. Because of the deficiencies of the cited references as well as the deficiencies of the arguments presented in the final Office Action, a *prima facie* case of obviousness has not been established. The commercial success of the invention further supports a finding of non-obviousness. As such, the present application is in complete condition for allowance and Appellant respectfully requests issuance of the patent.

Respectfully submitted,

DORITY & MANNING,
ATTORNEYS AT LAW, P.A.

October 12, 2010
Date



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8. CLAIMS APPENDIX

1. (Canceled)
2. (Canceled)
3. (Canceled)
4. (Canceled)
5. (Canceled)
6. (Canceled)
7. (Canceled)
8. (Canceled)
9. (Canceled)
10. (Canceled)

11. (Rejected) A computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system featuring integrated and automated on-line financial aid features specific to a given educational institution to a user, wherein said web-based application comprises:

a first information collection service for obtaining requested personal and financial information about a given student;

a financial aid estimation service for evaluating the information obtained via said first information collection service and generating a predicted amount of monetary aid that may be available for the student to use for education-related expenses at a given educational institution;

a federal link service for receiving an electronic copy of an Institutional Student Information Report (ISIR) document for the given student; a service for comparing information obtained via said first information collection service and the given student's ISIR document; a service for determining an authorized amount of financial aid the given student is eligible for at the given educational institution; and a service for providing an award notice to the given student based on the determination of authorized financial aid eligibility.

12. (Rejected) A computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system as in claim 11, wherein said web-based application further comprises a registration service for applying for and receiving a user identification element, and whereby said user identification element is utilized for obtaining future access to said web-based application, including various features and services thereof.

13. (Rejected) A computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system as in claim 12, further comprising a second information collection service, for obtaining additionally requested information related to personal demographics, financial matters, and educational endeavors of a given student.

14. (Canceled)

15. (Rejected) A computer-readable medium comprising instructions for

executing a web-based application for providing a multi-level financial aid system as in claim 11, further comprising a federal link service for electronically relaying federal aid eligibility information between the web-based application and processing systems of selected government agencies, wherein one of said selected government agencies corresponds to the United States Department of Education.

16. (Canceled)

17. (Rejected) A computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system as in claim 16, wherein selected information obtained via said student file establishment service comprises information obtained via said first information collection service and said second information collection service, federal aid eligibility information obtained via said federal link service, and enrollment information about a given student obtained from an educational institution.

18. (Canceled)

19. (Rejected) A computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system as in claim 17, further comprising a file processing service for reviewing information collected about a given student via said file establishment service and for determining eligibility for various types of financial aid that are potentially available for a student.

20. (Rejected) A computer-readable medium comprising instructions for

executing a web-based application for providing a multi-level financial aid system as in claim 19, further comprising a loan application service for electronically relaying master promissory note (MPN) documentation between a system user and a loan guarantor, wherein said loan guarantor is characterized as one who provides monetary assistance to a student for education-related expenses.

21. (Rejected) A computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system as in claim 15, wherein said federal aid link service provides links at the web-based application for directly connecting a user to a FAFSA on-line web-based location and to an IRS on-line web-based location.

22. (Rejected) A computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system as in claim 19, further comprising an integrated feature that automatically updates the web-based application, particularly updating information related to received documents and progress of financial aid processing.

23. (Rejected) A computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system as in claim 21, further comprising a reporting system service available to a user of the web-based application, for obtaining updated information about the financial aid system and progress involved with said file processing service thereof.

24. (Rejected) A computer-readable medium comprising instructions for

executing a web-based application for providing a multi-level financial aid system as in claim 19, further comprising a communications service for automatically generating and sending an electronic communication from a student or educational institution to a student financial aid processor.

25. (Rejected) A computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system as in claim 12, wherein the user identification element received via said registration service is utilized as an electronic signature for affirming various statements presented in accordance with the multi-level financial aid system.

26. (Canceled)

27. (Canceled)

28. (Canceled)

29. (Canceled)

30. (Canceled)

31. (Canceled)

32. (Canceled)

33. (Canceled)

34. (Canceled)

35. (Canceled)

36. (Canceled)

37. (Canceled)

38. (Canceled)

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48. (Canceled)
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50. (Canceled)
51. (Canceled)
52. (Canceled)
53. (Canceled)
54. (Canceled)
55. (Canceled)
56. (Rejected) A computer-readable medium comprising instructions for executing a web-based application for providing a multi-level financial aid system as in claim 11, further comprising a service for obtaining enrollment verification information for the given student from one or more specified educational institutions.
57. (Rejected) A computer-readable medium comprising instructions for

executing a web-based application for providing a multi-level financial aid system as in claim 11, wherein selected portions of the information obtained from said first information collection service, said service for obtaining a copy of an ISIR document and said service for obtaining enrollment verification information are reviewed by a financial aid processing center.

58. (Canceled)

59. (Rejected) A computer-readable medium comprising instructions for executing a web-based application as in claim 11, further comprising a service for determining whether the given student's corresponding information complies with federal regulatory standards for financial aid eligibility.

60. (Rejected) A computer-readable medium comprising instructions for executing a web-based application, for providing a multi-level financial aid system featuring integrated and automated on-line financial aid features specific to a given educational institution, wherein said web-based application comprises:

an information collection service for obtaining requested personal and financial information about one or more students;

a financial aid estimation service for evaluating the information obtained via said first information collection service and generating a predicted amount of monetary aid that may be available for each student to use for education-related expenses at a given educational institution;

a service for determining an authorized amount of financial aid each student is eligible for at the given educational institution;

a service for providing an award notice to each student based on the determination of authorized financial aid eligibility; and

a reporting service, available to the given educational institution, for generating reports of selected students and their respective financial aid packages.

61. (Rejected) The computer-readable medium comprising instructions for executing a web-based application of claim 60, further comprising:

a federal link service for receiving an electronic copy of an Institutional Student Information Report (ISIR) document for the given student; and
a service for comparing information obtained via said first information collection service and the given student's ISIR document.

62. (Rejected) The computer-readable medium comprising instructions for executing a web-based application of claim 60, further comprising a registration service for applying for and receiving a user identification element for gaining subsequent access to said web-based application, including various features and services thereof.

63. (Rejected) The computer-readable medium comprising instructions for executing a web-based application of claim 60, wherein said federal aid link service provides links at the web-based application for directly connecting a user to a FAFSA on-line web-based location and to an IRS on-line web-based location.

64. (Rejected) The computer-readable medium comprising instructions for

executing a web-based application of claim 60, further comprising a service for obtaining enrollment verification information for the given student from one or more specified educational institutions.

65. (Rejected) The computer-readable medium comprising instructions for executing a web-based application of claim 60, further comprising a service for determining whether the given student's corresponding information complies with federal regulatory standards for financial aid eligibility.

66. (Rejected) The computer-readable medium comprising instructions for executing a web-based application of claim 60, further comprising a loan application service for electronically relaying master promissory note (MPN) documentation between a system user and a loan guarantor, wherein said loan guarantor is characterized as one who provides monetary assistance to a student for education-related expenses.

9. EVIDENCE APPENDIX

The following two pages constitute a Declaration submitted by sole inventor Harry Weber in accordance with 37 C.F.R. § 1.132 setting forth evidence of commercial success.

PATENT
Attorney Docket No.: WBE-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	 	Examiner: Harish T. Dass
HARRY V. WEBER		Group Art Unit: 3693
Serial No.: 10/054,689		Our Account No.: 04-1403
Filed: November 13, 2001		Customer ID No.: 22827
For: VIRTUAL FINANCIAL AID OFFICE		

Harry Weber Declaration under 37 C.F.R. § 1.132

1. I, Harry Weber, am over the age of 21 years, am the sole inventor of the above-captioned application, and I make this Declaration based on my first hand knowledge.
2. I am the President of Weber & Associates, Inc., which I believe to be the assignee of the above-captioned application.
3. I am familiar with the subject matter described and claimed in the above-captioned application, and believe that the presently claimed web-based application for providing a multi-level financial aid system includes features embodied by the Virtual Financial Aid Office (VFAO) technology currently offered for sale by Weber & Associates, Inc.
4. The VFAO technology currently provided by Weber & Associates, Inc. and all commercial embodiments of such technology dating back to July 2001 encompasses all of the same features set forth in the presently claimed subject matter.

5. Since July 1, 2001, the VFAO technology provided by Weber & Associates, Inc. has been purchased for use by at least thirty-five (35) different educational institutions, including colleges and universities operating at a total of over eighty different locations in various states throughout the United States.

6. Since July 1, 2001 until present, the total income generated by Weber & Associates, Inc. from sales of their VFAO technology exceeds \$16,500,000.

6. The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the captioned application or any patent resulting therefrom, declares that all statements made of his own knowledge are true, and all statements made on information and belief are believed to be true.



Harry V. Weber, President
Weber & Associates, Inc.

3-12-06
Date

10. RELATED PROCEEDINGS APPENDIX

None